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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/388,351
Filing Date: September 01, 1999
Appellant(s): SNAPPER ET AL.

Ross A. Dannenberg
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 30, 2004.

(1)   ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2)   ***Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly

affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3)   ***Status of Claims***

The statement of the status of the claims contained in the brief is correct.

(4)   ***Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is

correct.

(5)   ***Summary of Invention***

The summary of invention contained in the brief is correct.

(6)   ***Issues***

The appellant's statement of the issues in the brief is correct.

(7)   ***Grouping of Claims***

Appellant's brief includes a statement that the pending claims do not stand or fall together and provides

reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8)   ***Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   *Prior Art of Record*

5,794,259	KIKINIS	08-1998
6,192,380	LIGHT ET AL.	02-2001
6,199,079	GUPTA ET AL.	03-2001
5,666,502	CAPPS	09-1997

Appellant's Specification.

(10)   *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set

forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3-4, 6-7, 9-15, 21-22, 24, 26-28, 31, 33-34, 36-44, 46-47, and 50-54 are rejected under 35

U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,794,259 to <u>Kikinis</u>**, issued August 11,**

1998, in view of U.S. Patent Number 6,192,380 B1 to <u>Light et al.</u>**, issued February 29, 2001, filed March**

31, 1998.

Regarding independent claim 3, <u>Kikinis</u> discloses (1) displaying on a computer screen a form

comprising a plurality of fields, each field having a field identifier and a data entry region into which a data

value can be written. (<u>Kikinis</u>, Figs. 1, 2.)

Further, <u>Kikinis</u> discloses (2) determining that a user has selected one of the plurality of fields. (<u>Kikinis</u>, col. 4, lines 15-20: "It will be apparent to those with skill in the art that there are a variety of ways the bubble feature may be activated. For example, the code could be provided so one may move the conventional screen cursor to a field and provide the activating signal by a hot key, displaying the bubble."; col. 4, lines 29-31: "In an alternative embodiment the bubble may be invoked at the first use of the control code, and used with the "Normal Fill" selection to fill fields one at a time.")

Further, <u>Kikinis</u> discloses (3) comparing the field identifier of the selected field to previously stored field identifiers and, upon finding a match, displaying a list of suggested data values previously stored in response to one or more different forms previously filled in by the user. (<u>Kikinis</u>, col. 3, lines 66-67: "The code executing matches field names in the form with tags to the prestored information about the user . . ."; col. 4, lines 7-10: "a preferred embodiment another Hot Key or key combination, or key and mouse button combination causes the control code executing to display a bubble 210 having a selection list 212 of tags for prestored information.")

Further, <u>Kikinis</u> discloses (4) in response to the user selecting one of the suggested data values, copying the selected one data value into the data entry region of the selected field. (<u>Kikinis</u>, col. 4, lines 22-25: "Any one of a variety of mechanisms might be incorporated for selection of a highlighted item in the list, which then is inserted into the field to which the bubble points.")

Further, <u>Kikinis</u> does not disclose (5) in response to the user entering a non-suggested data value, storing the non-suggested data value into a data storage area for future use. However, <u>Light et al.</u> teaches adding to a database a form field identifier and the data entered in the form either automatically or in response to a user query when that information was not previously found in the database. (<u>Light et al.</u>, col. 7. lines 11-19.) Moreover, one of ordinary skill in the art would have been motivated to implement such a step because it would have clearly increased the efficiency of filling out the form to have field values remembered the next time the user encountered the form, and because the field identifier would have assisted in locating the data the next time it was needed, and the data value entered in the form would have been needed to fill out the form the next time it

was presented. Therefore, it would have been obvious to one of ordinary skill in the art to have extended

Kikinis to implement step (5).

Further, Kikinis inherently discloses prior to step (4) detecting a user-initiated action and inhibiting

copying of the suggested data value into the data entry region until after receipt of the user-initiated action

inasmuch as Kikinis teaches copying the suggested data value into the data entry region upon detecting a user-

initiated action as discussed above regarding step (4) and such copying would not have taken place, *i.e.*, would

have been inhibited, until after receipt of the user-initiated action.

Regarding independent claim 4, the rejection of claim 3 above is fully incorporated herein.

Further, Kikinis teaches step (1) comprising displaying a web page using an Internet web browser and

that step (3) is preformed in the Internet Web browser. (Kikinis, col. 3, lines 47-53: "In an embodiment of the

present invention, control code is provided to automatically fill in such forms when user activated. The control

code may be a terminate-and-stay-resident (TSR) program, for example, or a plug-in module to a WEB browser

application. In a preferred embodiment the control code of the invention is a plug-in to a WEB browser.")

Regarding independent claim 6, the rejection of claim 3 above is fully incorporated herein.

Further, Kikinis does not teach step (3) comprising the step of comparing the field identifier of the

selected field to a first plurality of dynamically updated historical identifiers and also to a second plurality of

statically created identifiers and displaying suggested data values taken from both sources. However, Light et

al. teach storing identifiers from both sources. (Light et al., col. 4, lines 32-36: "Generally, the user will wish to

initially enter the personal information to be filled into the various forms. Alternatively, this step may be

skipped, and the system may only learn from user input, as will be described below."; *see also* col. 7, lines 11-

19.) One of ordinary skill in the art would have recognized that using identifiers both from a statically created

profile and extracted from various web sited would have conferred the benefit of providing the greatest

likelihood that one of the suggested data values would in fact be the data value that the user wished to insert into

the form. Therefore, it would have been obvious to one of ordinary skill in the art to have implemented the

steps recited.

Regarding dependent claim 7, <u>Kikinis</u> teaches comparing the field identifier of the selected field to a

statically created common names data store comprising frequently used field identifiers that are mapped to one

or more field identifiers in the user profile. (<u>Kikinis</u>, col. 3, lines 35-38; 66-67: "The tool according to an

embodiment of the present invention allows a user to quickly link pre-stored information of the sort most

usually required by forms to fields in forms, and to transfer such information to the form fields."; "The code

executing matches field names in the form with tags to the prestored information about the user.")

Regarding independent claim 9, the rejection of claim 3 above is fully incorporated herein.

Further, <u>Kikinis</u> teaches a bubble analogous to a pop-down list of suggestions (<u>Kikinis</u>, Fig. 2, block

210) and also teaches navigating through the bubble using a computer input device to select the one selected

data value, and removing the pop-down list after the user has made the selection. (<u>Kikinis</u>, col. 4, lines 7-15: "In

a preferred embodiment another Hot Key or key combination, or key and mouse button combination causes the

control code executing to display a bubble 210 having a selection list 212 of tags for prestored information. FIG.

2 shows how the bubble 210 could look on the screen, after being activated by holding a key and clicking a

mouse button. The user can move a highlight bar 211 up and down, and select an item to be pasted into the field

where tip (208) is pointing.")

Regarding dependent claim 10, <u>Kikinis</u> does not teach providing an extendable corner tab permitting

the pop-down list to be resized by the user. However, notice is taken that such extendable corner tabs were well

known in the art prior to applicants' claimed invention, as was the benefit of permitting the user to re-size the

list as needed when suggested values exceeded the size of the list as displayed by default. Therefore, it would

have been obvious to one of ordinary skill in the art at the time of the invention to have implemented the step

recited (see Response to Arguments).

Regarding independent claim 11, the rejection of claim 3 above is fully incorporated herein.

Further, Kikinis does not teach providing the user with an option to globally disable future storage of

field data values. However, Light et al. teach disabling storage of field data values on a case-by-case basis.

(Light et al., col. 7, lines 11-15.) One of ordinary skill in the art would have been motivated to adopt the

teaching of Light et al. by the recognition that there may have been times when users would be entering values

that would only be used once, *i.e.,* that the user would not want stored for future use. Moreover, one of ordinary

skill in the art would have recognized from the description in the cited portion of Light et al. of iterating through

field by field that it would have been desirable to allow the user to globally disable storage of data values to

avoid the irritation of having to repeatedly enter identical negative responses to the question of whether data

values should be stored. Therefore, it would have been obvious to one of ordinary skill in the art to provide the

user with an option to globally disable future storage of field data values.

Regarding independent claim 12, the rejection of claim 3 above is fully incorporated herein.

Further, Kikinis does not teach providing the user with an option to disable storage of field data values

on a field by field basis. However, Light et al. teach disabling storage of field data values on a field by field

basis. (Light et al., col. 7, lines 11-15.) One of ordinary skill in the art would have been motivated to adopt the

teaching of Light et al. by the recognition that there may have been times when users would be entering values

that would only be used once, *i.e.,* that the user would not want stored for future use. Therefore, it would have

been obvious to one of ordinary skill in the art to provide the user with an option to disable storage of field data

values on a field by field basis.

Regarding independent claim 13, the rejection of claim 3 above is fully incorporated herein.

Further, <u>Kikinis</u> does not teach detecting a password field and forcing a user to select whether the data value therein will be stored for later use. However, notice is taken that at the time of applicants' invention HTML 4.0 provided a form element attribute for specifying a password field so that password characters would be masked when typed into a form field and displayed. Accordingly, one of ordinary skill in the art would have recognized that the user may not have wanted to save a password in a place where it might accessible for use by other users. Therefore, it would have been obvious to one of ordinary skill in the art to have implemented the step recited.

Regarding independent claim 14, the rejection of claim 3 above is fully incorporated herein.

Further, <u>Kikinis</u> does not teach detecting a credit card number field and suppressing suggestions in response thereto. However, notice is taken that at the time of applicants' invention HTML 4.0 provided a form element attribute for specifying a password field so that password characters would be masked when typed into a form field and displayed, and that this masking equally could have been applied to credit card numbers. Moreover, one of ordinary skill in the art would have recognized that the user would not have wanted to save a credit card number in a place where it might accessible for use by other users. Therefore, it would have been obvious to one of ordinary skill in the art to have implemented the step recited.

Regarding independent claim 15, the rejection of claim 3 above is fully incorporated herein.

Further, <u>Kikinis</u> does not teach comparing the field identifier of the selected field to previously stored field identifiers that reside on a web site different from the computer on which the form is displayed. However, <u>Light et al.</u> inherently teach such a step inasmuch as they disclose storing field identifiers from whatever web site the user happens to be visiting, and then comparing the field identifier of the selected field to the stored field identifiers. (<u>Light et al.</u>, col. 7, lines 11-19; col. 5, lines 61-65.) Moreover, one of ordinary skill in the art would have been motivated to implement such a step because comparing field identifiers from multiple websites would

have increased the likelihood that a suggested value could be found. Therefore, it would have been obvious to one of ordinary skill in the art to have implemented the step recited.

Regarding independent claim 21, <u>Kikinis</u> discloses a computer system comprising a processing unit, a memory, a display unit, and an interface to a network inasmuch as such a system inherently would have been necessary for the web browser application disclosed by <u>Kikinis</u>. (<u>Kikinis</u>, col. 3, lines 50-52.)

Further, the rejection of claim 4 above is fully incorporated herein.

Regarding dependent claim 22, it is inherent in <u>Kikinis</u>' disclosure of a bubble, discussed above regarding claim 3, that a keystroke or mouse click (*i.e.,* selecting a suggested data value from the pop-up box) would be detected and that the system would be inhibited from pasting a suggested value into the form field until after receiving the keystroke or mouse click.

Regarding dependent claim 24, that claim is rejected for the same reasons given above for the rejection of claim 6.

Regarding dependent claim 26, that claim is rejected for the same reasons given above for the rejection of claim 9.

Regarding dependent claim 27, that claim is rejected for the same reasons given above for the rejection of claim 12.

Regarding dependent claim 28, that claim is rejected for the same reasons given above for the rejection of claim 15.

Regarding independent claim 31, a computer-readable medium containing instructions for performing the same steps recited in claim 3, the rejection of claim 3 above is fully incorporated herein.

Further, Kikinis inherently teaches a computer-readable medium inasmuch as Kikinis teaches a CPU capable of executing code. (Kikinis, col. 1, lines 59-67.)

Regarding independent claim 33, a computer-readable medium containing instructions for performing the same steps recited in claim 6, the rejection of claim 6 above is fully incorporated herein.

Further, Kikinis inherently teaches a computer-readable medium inasmuch as Kikinis teaches a CPU capable of executing code. (Kikinis, col. 1, lines 59-67.)

Regarding dependent claim 34, the rejection of claim 7 above is fully incorporated herein.

Regarding independent claim 36, a computer-readable medium containing instructions for performing the same steps recited in claim 9, the rejection of claim 9 above is fully incorporated herein.

Further, Kikinis inherently teaches a computer-readable medium inasmuch as Kikinis teaches a CPU capable of executing code. (Kikinis, col. 1, lines 59-67.)

Regarding dependent claim 37, the rejection of claim 10 above is fully incorporated herein.

Regarding independent claim 38, a computer-readable medium containing instructions for performing the same steps recited in claim 11, the rejection of claim 11 above is fully incorporated herein.

Further, Kikinis inherently teaches a computer-readable medium inasmuch as Kikinis teaches a CPU capable of executing code. (Kikinis, col. 1, lines 59-67.)

Regarding independent claim 39, a computer-readable medium containing instructions for performing the same steps recited in claim 12, the rejection of claim 12 above is fully incorporated herein.

Further, Kikinis inherently teaches a computer-readable medium inasmuch as Kikinis teaches a CPU capable of executing code. (Kikinis, col. 1, lines 59-67.)

Regarding independent claim 40, a computer-readable medium containing instructions for performing the same steps recited in claim 13, the rejection of claim 13 above is fully incorporated herein.

Further, Kikinis inherently teaches a computer-readable medium inasmuch as Kikinis teaches a CPU capable of executing code. (Kikinis, col. 1, lines 59-67.)

Regarding independent claim 41, a computer-readable medium containing instructions for performing the same steps recited in claim 14, the rejection of claim 14 above is fully incorporated herein.

Further, Kikinis inherently teaches a computer-readable medium inasmuch as Kikinis teaches a CPU capable of executing code. (Kikinis, col. 1, lines 59-67.)

Regarding independent claim 42, a computer-readable medium containing instructions for performing the same steps recited in claim 15, the rejection of claim 15 above is fully incorporated herein.

Further, Kikinis inherently teaches a computer-readable medium inasmuch as Kikinis teaches a CPU capable of executing code. (Kikinis, col. 1, lines 59-67.)

Regarding independent claim 43, the rejection of claim 31 above is fully incorporated herein.

Further, Kikinis does not teach do not teach inhibiting display of suggested data values for password fields unless the URL from which the form was generated matches a previously stored URL. However, it would have been obvious to one of ordinary skill in the art to have displayed suggested password values only when

matching URLs could be found because one of ordinary skill in the art would have recognized that passwords

could have been different from site to site.

Regarding independent claim 44, the rejection of claim 31 above is fully incorporated herein.

Further, <u>Kikinis</u> teaches the computer-executable instructions comprising a web browser that displays

web pages and provides web navigation functions. (<u>Kikinis</u>, col. 3, lines 50-52.)

Regarding independent claim 46, the rejection of claim 31 above is fully incorporated herein.

Further, <u>Kikinis</u> does not teach detecting a username field and then automatically copying a password

previously used in response to the username into a password field. However, such a step would have been

obvious to one of ordinary skill in the art because one of ordinary skill in the art would have recognized that that

usernames and passwords are generally associated with each other.

Regarding dependent claim 47, the rejection of claim 43 above is fully incorporated herein.

Regarding dependent claim 50, <u>Kikinis</u> does not teach detecting a username field and then

automatically copying a password previously used in response to the username into a password field. However,

such a step would have been obvious to one of ordinary skill in the art because one of ordinary skill in the art

would have recognized that that usernames and passwords are generally associated with each other.

Regarding dependent claim 51, the rejection of claim 43 above is fully incorporated herein.

Regarding independent claim 52, the rejection of claim 46 above is fully incorporated herein.

Regarding dependent claim 53, the rejection of claim 43 above is fully incorporated herein.

Regarding independent claim 54, the rejection of claim 46 above is fully incorporated herein.

Further, the combination of Kikinis and Light et al. does not does not teach prompting the user to indicate whether a password field should be stored for a URL when no indication to store a password has been previously indicated. However, it would have been obvious to one of ordinary skill in the art to have so prompted the user because one of ordinary skill in the art would have recognized that the user might not want the password automatically stored because the user might not have wanted to give others access to the password and also would have recognized that if the user had not previously stored the password the reason might be that the user had not yet had the opportunity to do so, and did in fact want the password stored.

Claims 5, 23, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of Light et al. and further in view of U.S. Patent Number 6,199,079 to Gupta et al., issued March 6, 2001, filed March 20, 1998.

Regarding independent claim 5, the rejection of claim 3 above is fully incorporated herein.

Further, Kikinis does not teach comparing the field identifier of the selected field to previously stored field identifiers having the same URL and, upon finding a match, displaying the suggested data values having the same URL. However, Gupta et al. teach a form's URL as a criterion for selecting form data (Gupta et al., col. 8, lines 26-27), which would have suggested the recited step to one of ordinary skill in the art because such a person would have recognized that field identifiers having the same URL were likely to represent the same fields on the same form. Therefore, it would have been obvious to one of ordinary skill in the art to have compared the field identifier of the selected field to previously stored field identifiers having the same URL and, upon finding a match, displayed the suggested data values having the same URL.

Regarding dependent claim 23, the rejection of claim 5 above is fully incorporated herein.

Regarding independent claim 32, the rejection of claim 31 above is fully incorporated herein.

Further, the rejection of claim 5 above is fully incorporated herein.

Claims 8, 25 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in

view of Light et al. as applied to claims 7, 21, and 33, respectively, above, and further in view of

applicants' specification.

Regarding claims 8, 25, 35, Kikinis does not teach comparing the field identifier of the selected field to

field identifiers in a statically created standard vCard schema. However, applicants disclose in the specification

(page 2, line 21) that the standard vCard schema was known in the art prior to applicants' invention. One of

ordinary skill in the art would have recognized the benefit of being able to compare selected field identifiers to

field identifiers in a schema conforming to an established standard. Therefore, it would have been obvious to

one of ordinary skill in the art to have implemented the step recited in claims 8, 25, and 35 respectively.

Claims 16-17, 19-20, 48-49, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Light et al. in view of U.S. Patent Number 5,666,502 to Capps, issued September 9, 1997.

Regarding independent claim 16, Light et al. teach (1) displaying on the user's computer a first form

comprising a first plurality of text fields each comprising a field identifier and a data entry region into which a

data value can be written. (Light et al., col. 2, lines 53 – col. 3, line 17.)

Further, Light et al. teach (2) entering a data value into one of the first plurality of text fields and storing

the entered data value into a database. (Light et al., col. 7, lines 11-19.) Light et al. do not disclose storing the

entered data into a local storage area on the user's computer. However, Capps teaches storing suggested values

on the user's computer inasmuch as Capps teaches a computer system (Capps, Fig. 1) that stores and uses a

history list of suggested values (Capps, col. 10, lines 3-5), which would have suggested to one of ordinary skill

in the art to store entered data on the user's local computer because such a step would have made data readily

available without risking the potential inefficiencies of accessing data through a network. Therefore, it would

have been obvious to one of ordinary skill in the art to have entered a data value into one of the first plurality of

text fields and storing the entered data value into a local storage area on the user's computer.

Further, Light et al. disclose (3) displaying a second form comprising a second plurality of text fields

comprising field identifiers different from those in the first form inasmuch as Light et al. teach that their

invention is embodied in a web browser that visits a plurality of web pages (Light et al., col. 2, lines 53-62).

Further, Light et al. teach (4) detecting whether one of the text fields in the second form is correlated

with one of the text fields on the first form despite having a different field identifier, and retrieving a

correspondingly previously stored data value in response thereto. (Light et al., col. 6, lines 61-67: "At block

590, the system queries whether the data filled in matches information in the database. This is applicable if a

different tag is used by the web page for known data. For example, the tag 'Christian name' may be used in a

foreign web page, for the data tagged 'first name' in the database. The data entered by the user would still be

'John', or the appropriate first name.")

Further, Light et al. do not teach suggesting the data value retrieved in step (4) to the user as a possible

value to be entered into the second form. However, Capps teach displaying values from a history list to the user

as possible values to be entered into the second form. (Capps, col. 13, lines 2-4.) One of ordinary skill in the art

would have recognized that such a step would have provided the benefit of allowing the user to determine

whether a suggested value was appropriate instead of inserting a matched value that might be wrong, or not

offering the user any value at all. Therefore, it would have been obvious to one of ordinary skill in the art to

have extended Light et al. to implement step (5).

Regarding dependent claim 17, as noted above regarding claim 16, Light et al. teach generating a

plurality of forms from a plurality of web sites.

Regarding dependent claim 19, Light et al. do not teach retrieving and displaying in a list previously

stored data values. However, Capps teaches such a step. (Capps, col. 13, lines 2-4.) One of ordinary skill in the

art would have recognized that such a step would have provided the benefit of allowing the user to determine

whether a suggested value was appropriate instead of inserting a matched value that might be wrong, or not

offering the user any value at all. Therefore, it would have been obvious to one of ordinary skill in the art to

have extended Light et al. to implement the step recited in claim 19.

Regarding dependent claim 20, Light et al. teach inhibiting the release of the suggested data value

until the user has manipulated a user input device. (Light et al., col. 6, lines 25-29: "At block 550, the user is

queried whether it is acceptable to fill-in the data.")

Regarding dependent claim 48, Light et al. do not teach detecting a username field and then

automatically copying a password previously used in response to the username into a password field. However,

such a step would have been obvious to one of ordinary skill in the art because one of ordinary skill in the art

would have recognized that that usernames and passwords are generally associated with each other.

Regarding dependent claim 49, Light et al. do not teach do not teach inhibiting display of suggested

data values for password fields unless the URL from which the form was generated matches a previously stored

URL. However, it would have been obvious to one of ordinary skill in the art to have displayed suggested

password values only when matching URLs could be found because one of ordinary skill in the art would have

recognized that passwords could have been different from site to site.

Regarding dependent claim 55, Light et al. do not teach prompting the user to indicate whether a

password field should be stored for a URL when no indication to store a password has been previously

indicated. However, it would have been obvious to one of ordinary skill in the art to have so prompted the user because one of ordinary skill in the art would have recognized that the user might not want the password automatically stored because the user might not have wanted to give others access to the password and also would have recognized that if the user had not previously stored the password the reason might be that the user had not yet had the opportunity to do so, and did in fact want the password stored.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Light et al.</u> in view of <u>Capps</u> as applied to claim 16 above, and further in view of applicants' specification.

Neither <u>Light et al.</u> nor <u>Capps</u> teach using Bayesian inference techniques. However, as applicants admit beginning at line 21 on page 20 of their specification, Bayesian inference techniques were well known in the art at the time of applicants' claimed invention. Moreover, one of ordinary skill in the art would have been motivated to use Bayesian inference techniques to determine whether two form fields were correlated because such techniques predict probabilities; *i.e.,* if there was a high probability that two form fields matched, then one would probably want to use a value from the first field in filling in the second. Therefore, it would have been obvious to one of ordinary skill in the art to have extended the combination of <u>Light et al.</u> and <u>Capps</u> to use Bayesian inference techniques.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Kikinis</u> in view of <u>Light et al.</u> and further in view of <u>Capps</u>.

Regarding dependent claim 45, the rejection of claim 31 above is fully incorporated herein.

Further, <u>Kikinis</u> does not disclose that the computer-executable instructions permit the user to delete one of the previously stored suggested data values. However, <u>Capps</u> teaches removing the least recently used item from a history list when the list has reached maximum size. (<u>Capps</u>, col. 16, lines 13-15.) Moreover, one of

ordinary skill in the art would have recognized that not only would it be beneficial to automatically remove

items so that the list did not grow too large, but also that sometimes when the list got too large users might want

to delete an item other than the least recently used. Therefore, it would have been obvious to one of ordinary

skill in the art to permit the user to delete one of the previously stored suggested data values.

(11)   Response to Argument

Beginning on page 7 of Appellant's Brief (hereinafter the Brief), Appellant argues the following issues

which are accordingly addressed below.

a.   **"With respect to all claims rejected under a combination of Kikinis and Light, the examiner has**

not established a *prima facie* case of obviousness because the examiner has not provided a motivation or

suggestion to combine the two references." (page 7 of the Brief).

The examiner respectfully disagrees. Both references (Kikinis and Light) are in the same general field of

endeavor, since both references deal with methods of filling in forms on Web pages (see Abstracts of both

references). An embodiment of Kikinis comprises a pop-up bubble of suggestions for filling in portions of said

forms (Kikinis Figure 2), as well as teaching that a user can move a highlight bar 211 up and down, and select

an item to be pasted into the field where tip (208) is pointing (see Kikinis column 4 lines 13-15). Light teaches

saving a user query (data entered in a form) in a database when said query is not previously found in said

database. In other words, Light saves a new user entry (i.e. a non-suggested data value) into a database, if not

previously found, to be used for later use. The examiner applies this teaching to Kikinis's fill-in form (i.e.

applied to Kikinis's bubble selection, see Figure 2 item 210). The addition of this feature increases Kikinis's

form filling efficiency and convenience by automatically remembering new data items (and offering said new

items at later times) as a user's situation changes over time (i.e. obtaining new credit cards, new addresses, etc.).

It is respectfully submitted that increasing efficiency by remembering new data items is a proper motivation,

especially for users (i.e. the military, or frequent travelers) who must change their personal information on a

regular basis. The skilled artisan is cognizant of this problem regarding users who frequently move to new

locations, and who update personal information due to marriage, etc.

b.   "However, the 'highlighted item in the list' disclosed by Kikinis is a name tag and not its

associated data value, as recited in claim 21." (page 8, near bottom, to page 9, of the Brief).

The examiner respectfully disagrees. Kikinis's Figure 2 bubble suggestions (i.e. "Resume") represents a

collection of data values used for filling in a form. Since each suggestion is clearly associated with one or more

specific values, the skilled artisan using Kikinis's invention is aware that selecting a displayed suggestion is

analogous to (and results in) selection of the associated data values themselves. A user of Kikinis wishes to fill

in specific data values as represented by the suggestions, therefore, it would have been at least obvious to the

skilled artisan that analyzing/selecting the displayed bubble suggestion "Resume", or "American Express [TM]

Acct. #1", is analogous to analyzing/selecting its representative set of data value(s), and therefore, said data

value(s) can be fairly interpreted as being "displayed" in a sense by its representative displayed suggestion.

Kikinis teaches matching field names in a form to prestored information about a user (Kikinis column 3 lines

65-67).

The examiner respectfully disagrees with Appellant's assertion that a user (of Kikinis's invention) is

unaware of the actual data values that may be selected (bottom of page 9 of the Brief). A user is made aware of

set(s) of data represented by Kikinis's bubble listing of Figure 2. As explained above, displayed item "American

Express [TM] Acct. #1" represents the suggestion of a set of data, and choosing said item is analogous to choosing

its credit card number and expiration date.

c.   "However, Kikinis does not teach or suggest inhibiting the copying of the suggested data value

into the data region until after receipt of the user-initiated action." (pages 10-11, of the Brief)

The examiner respectfully disagrees. Appellant's assertion is directed to the last limitation of pending

independent claim 3. Kikinis produces a pop-up bubble of suggestions subsequent to an initial user action (i.e.

Hot Key or key combination) (Kikinis column 4 lines 7-15). At this point Kikinis does not know what the user

wants to choose, therefore, said bubble waits, and copying of data is inhibited, until Kikinis detects a selection

(another user initiated action). It is respectfully noted that this subsequent selection occurs after "receipt of the

user-initiated action", claim 3 does not prevent any subsequent actions from occurring after said initial receipt.

d.   "The referenced HTML 4.0 technology is not relevant to saving or not saving password data

values nor is it relevant to forcing the user to make that choice." (page 12 of the Brief).

The examiner respectfully disagrees. HTML 4.0 provides a form element attribute for masking

password characters when typed into a field. Since masking passwords reminds a user of the sensitivity of

password stealing (and tells the user that this is a security related field), the skilled artisan may not wish to have

such information saved, therefore it would have been obvious to one of ordinary skill in the art at the time of the

invention to implement masking of sensitive data (i.e. passwords, credit card numbers, etc.).

The examiner's answers as set forth above are also applied to Appellant's arguments on pages 13-24.
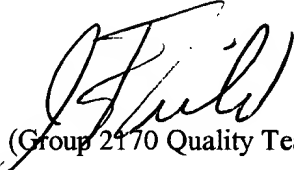
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

William L. Bashore
July 25, 2004

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